

### **Remarks**

Claims 1 - 14 and 21 - 25 remain in the application, and claims 15 - 20 were previously cancelled. This transmittal is presented in response to the third office action and is believed to completely resolve each issue as raised by the examiner. Applicant believes the claims as amended to be non-obvious and patentably distinct from all prior art.

#### **OA Item #1: Claims 1-14 and 21-25 Rejected under Obvious Type Double Patenting:**

The examiner has rejected claims 1 - 14 and 21 - 25 under obvious type double patenting over claims 1 - 9 of US patent 5,246,046 and claims 1 - 11 of US patent RE36,131 in view of Hunter (GB '356), Martindale ('797), Coleman ('884) and Hoeting et al ('870). The applicants respectfully traverse the examiner's rejection on the basis that the applicants' invention in the appended modified claims is substantially different than the cited prior art patents of the applicant and on the basis of both negative teachings and closely related commercial success.

**Substantially Different:** The applicants urge that the teachings of '046 and '131 are far removed from that of the amended claims of the current application. Applicants note that '046 and '131 were directed toward resisting the spillage of liquid bubble solution whereas applicants current application is directed towards resisting the spillage of candy powder or candy beads or the like while having an open container access so as to be able to coat a lollipop type confection with the candy powder or candy beads. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other perform some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains edible matter.

**Negative Teaching:** As noted in the applicant's previous office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must

be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same "spill resistant" closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The applicant's suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

Commercial Success: The applicants respectfully suggest that the examination of the subject patent application is nearly identical to the examination of the patent application of which the subject application is a continuation. Specifically in examining the 5,246,046/RE36,131 application, bubble solution containers having some form of a funnel and/or spill resistance such as 2,858,639, 3,579,898, 3,818,627, 4,840,597, and 5,088,950 and containers for liquid having funnels such as 676,924,

1,210,397, 5,022,559, and 5,105,975 were cited. However, in spite of such combined bubble solution container art and such funneled container art, the '046/RE36,131 examiner did not declare the invention to be obvious. Time has since vindicated this examiner's position. In 1993, approximately one year after the '046 application was filed, a product incorporating the technology disclosed in the '046 application was introduced to the market by the Little Kids corporation of Providence, Rhode Island. Many other similar products made by many other companies also using the technology disclosed in '046 soon followed. In 1995, one of the current applicants, Michael R. Schramm, licensed the '046 patent to the Strombecker corporation of Chicago, Illinois. Subsequent to the Strombecker license agreement, Schramm also sublicensed Little Kids, inc., Imperial Toy, Inc., Toys R Us, inc., and Placo, Inc. In the decade since the first spill resistant bubble solution container incorporating '046 technology was introduced to the market, the product in it's many different embodiments, has gone on to generate multiple millions of dollars worth of retail sales. Various versions of the container continue to be available in every state of the union in stores such as Wal Mart, K Mart, and Toys R Us. The Applicants suggest that the spill resistant candy container is no more obvious

In conclusion, the Applicants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given the substantially different invention, the negative teaching, and the related commercial success, it is urged that an "obvious" rejection is not proper and it is requested that the examiner withdraw the rejection.

**OA Item #2: Claims 1-14 and 21-25 Rejected under Obvious Type Double Patenting:**

The examiner has rejected claims 1 – 14 and 21 – 25 under obvious type double patenting over claims 1 – 29 of US patent 6,386,138 in view of Hunter (GB '356), Martindale ('797), Coleman ('884) and Hoeting et al ('870). The applicants respectfully traverse the examiner's rejection on the basis that the applicants' invention in the appended modified claims is substantially different than the cited prior art patents of the applicant and on the basis of both negative teachings and closely related commercial success.

**Substantially Different:** The applicants urge that the teaching of '138 is far removed from that of the amended claims of the current application. Applicants note that '138 was directed toward resisting the spillage of a liquid dye while coloring an Easter egg whereas applicants current application is directed towards resisting the spillage of candy powder or candy beads or the like while having an open container access so as to be able to coat a lollipop type confection with the candy powder or candy beads. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other performing some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains a different work piece.

**Negative Teaching:** As noted in the applicant's previous office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same "spill resistant" closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural

tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The applicant's suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

Commercial Success: The applicants respectfully suggest that the examination of the subject patent application is nearly identical to the examination of the patent application of which the subject application is a continuation. Specifically in examining the 5,246,046/RE36,131 application, bubble solution containers having some form of a funnel and/or spill resistance such as 2,858,639, 3,579,898, 3,818,627, 4,840,597, and 5,088,950 and containers for liquid having funnels such as 676,924, 1,210,397, 5,022,559, and 5,105,975 were cited. However, in spite of such combined bubble solution container art and such funneled container art, the '046/RE36,131 examiner did not declare the invention to be obvious. Time has since vindicated this examiner's position. In 1993, approximately one year after the '046 application was filed, a product incorporating the technology disclosed in the '046 application was introduced to the market by the Little Kids corporation of Providence, Rhode Island. Many other similar products made by many other companies also using the technology disclosed in '046 soon followed. In 1995, one of the current applicants, Michael R. Schramm, licensed the '046 patent to the Strombecker corporation of Chicago, Illinois. Subsequent to the Strombecker license agreement, Schramm also sublicensed Little Kids, inc., Imperial Toy, Inc., Toys R Us, inc., and Placo, Inc. In the decade since the first spill resistant bubble solution container incorporating '046 technology was introduced to the market, the product in it's many different embodiments, has gone on to generate multiple millions of dollars worth of retail sales. Various versions of the container continue

to be available in every state of the union in stores such as Wal Mart, K Mart, and Toys R Us. The Applicants suggest that the spill resistant candy container is no more obvious

In conclusion, the Applicants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given the substantially different invention, the negative teaching, and the related commercial success, it is urged that an “obvious” rejection is not proper and it is requested that the examiner withdraw the rejection.

**OA Item #3: Rejection of Claimed Benefit of Earlier Filed Applications under 35 USC § 120:**

In accordance with the examiners statement that the present application has an effective filing date of 11/6/00, the applicants have amended the specification so as not to claim the benefit of prior application filing dates.

**OA Item #4: Claims Rejection under 35 USC § 103(a) - Obviousness:**

The examiner has rejected claims 1 – 14 and 21 – 25 under 35 USC § 103(a) based on Hunter (GB ‘356) in view of Schramm (‘046) and Martindale (‘797) and Coleman (‘884)/Hoeting et al (‘870). The applicants respectfully traverse the examiner’s rejection on the basis of both negative teachings and closely related commercial success.

Negative Teaching: As noted in the applicant’s previous office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

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closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve the their own recognized problem of spill resistance of accessible particulate candy. The applicant's suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

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**OA Item #5: Claims Rejection under 35 USC § 112, 1<sup>st</sup> para - new matter:**

The examiner has rejected claims 21 and 23 – 25 under 35 USC § 112, first paragraph, arguing that the use of the phrase "edible fluent non-gaseous material" constitutes new matter. While the applicants respectfully disagree with the examiner based on the reasons set forth in a prior office action response, the applicants note that the claims have been amended to delete the terms that the examiner regards as new matter. It is therefore requested that the examiner withdraw the new matter rejection.



**Conclusion:**

Applicants submit that the amendments to the claims and the arguments presented herein have established the claims to be in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: February 12, 2005      Respectfully submitted,

  
Vivian A. Schramm

  
Michael R. Schramm